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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,292	03/27/2001	Daniel F. Williams	PSTM0042/MRK	1726

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EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/820,292	WILLIAMS ET AL.	
	Examiner	Art Unit	
	Jamisue A. Webb	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-169 is/are pending in the application.
- 4a) Of the above claim(s) 28-38, 66-76, 104-114 and 142-169 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27, 39-67, 75-103 and 115-141 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-169 are pending.
2. Claims 28-38, 66-76, 104-114, and 142-169 are withdrawn from consideration.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-10, 22-27, 39-48, 60-65, 77-86, 98-103, 115-124, and 136-141 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwab et al. (US 2002/0019777).
3. With respect to Claims 1, 22-27, 39, 60-65, 77, 98-103, 115, 136-141: Schwab discloses the use of an online merchandise return computer system (see abstract, the examiner considers the online merchandise return computer system to include both the merchant computer, as well as the third party/agent computer, due to the fact that they both computers cooperatively work together, to process and return a product) where the computer system is programmed to:
 - a. Save a set of return rules which is inputted by a merchant (Paragraphs 0052 and 0053);
 - b. Receive an online return request by a consumer (Paragraph 0052);
 - c. Process return request according to the set of return rules (Paragraph 0053).

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4. With respect to Claims 2-9, 40-47, 78-85, and 116-123: Schwab discloses the use of a set or return questions (Parameter request, reference numeral 605, product return parameters, such as description of product and condition of product), and processing the return according to the rules (See Paragraphs 0012, and Paragraph 0053).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 10-12, 27, 48-50, 65, 86-88, 103, and 124-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab et al. in view of Kara (6,233,568).

8. With respect to Claims 10, 11, 48, 49, 86, 87, 124 and 125: Schwab, as disclosed above for Claims 1, 39, 11 and 115, disclose the use of shipping the return to the manufacturer, but fails to disclose selecting a carrier for shipment and calculating the shipping rate for the return. Kara

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discloses the use of a system used to select a carrier for shipment and calculating shipping rates for a plurality of carriers (See Figure 8, with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schwab, to include the ability to select a carrier and calculate the shipping rates for the carriers, according to Kara, in order to for the user to make an informed choice as to the most preferable method of shipment. (See Kara, abstract).

9. With respect to Claims 12, 27, 50, 65, 88, 103, 126 and 141: See Kara Figure 8.

10. Claims 13-21, 27, 51-59, 65, 89-97, 127-135 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab and Kara as applied to claims 11, 49, 87, and 125 above, and further in view of UPS® Service Guide (www.ups.com) and FedEx® Services (www.fedex.com) and Barnett et al. (6,369,840).

11. With respect to Claims 13-16, 27, 51-54, 65, 89-92, 127-130: Schwab and Kara discloses an onscreen interactive display with a selection and comparison section for a plurality of carriers with a plurality of services (See Kara, Figure 8). However Kara does not specifically disclose the rates being calculated with respect to time. Both UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the time sensitive “urgency” services, as disclosed by FedEx® and UPS®, in order to ship thing and compete with a time advantage using guaranteed delivery times and to reduce costs, when delivery time is not of importance. (See Fed Ex Page 1). Kara, UPS® and FedEx® fail to disclose the use of a graph which simultaneously displays a graph of shipping fees and services,

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where one axis being date and one axis being time and where each cell is located at the intersection of the date and time. Barnett discloses the use of a calendar which can be used for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to display the calculation of shipping rates, calculated by Kara, UPS® and FedEx®, in the format of a plurality of cells with date on one axis and time on another, as disclosed by Barnett, in order to provide a multi-layers system wherein different categories can be overlaid on one another providing a single integrated display that allows a user to order or purchase a system based on the calendar day and time (See Barnett, column 2).

12. With respect to Claims 17, 55, 93 and 131: See Schwab, return transaction 619.

13. With respect to Claims 18, 56, 94, and 132: See Kara, Figure 9.

3. Claims 19-21, 57-59, 95-97, and 133-135 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab and Kara, in further view of Siegel (US 2004/0143519).

4. With respect to Claims 19, 20, 57, 58, 95, 96, 133 and 134: Schwab and Kara, as disclosed above, fails to disclose the use of generating a return shipping label and printing the shipping label. Siegel discloses the use of an online merchandise return system, which prints shipping labels for returns (See abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Schwab and Kara, to include the function of providing shipping labels for the return, in order to simplify processing for both the shipping agent and the user. (See Siegel, Page 5)

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14. With respect to Claims 21, 59, 97, and 135: See Siegel, Figure 1A, and Figure 5 with corresponding detailed descriptions

Response to Arguments

5. Applicant's arguments, see Pages 40-44, filed 11/14/05, with respect to the rejection(s) of claim(s) 1-27, 39-65, 77-103, and 115-141 under 102(e) and 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Schwab et al. see rejection above.

6. With respect to Applicant's arguments that the declarations of John Dietz should be considered. The submission of declarations in an IDS is considered to be improper. See MPEP 715, 716 and 718 for the proper procedures for filing a declaration.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jamisue Webb", is positioned above the printed name.

Jamisue Webb
Patent Examiner
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